





IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1942

HARVEY S. COVER,

Petitioner,

vs.

NATHAN SCHWARTZ, doing busi-
ness as Hygeia Respirator Co.,
Respondent.

No. 906

PETITION FOR REHEARING

Of Petition for Writ of Certiorari to the United States
Circuit Court of Appeals for the Second Circuit.

JOSHUA R. H. POTTS,
EUGENE VINCENT CLARKE,
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*To the Honorable the Chief Justice of the United States,
and Associate Justices of the Supreme Court of the
United States:*

Petitioner, Harvey S. Cover, presents this, his Petition
for a Rehearing in the above entitled cause, and in support
thereof respectfully shows:

Preamble

We have endeavored in the original Petition for Writ of Certiorari herein, to point out to this Honorable Court that there is a distinct and definite conflict of the interpretation of the law as laid down by this Court in *Cuno v. Automatic Service Corp.*, 314 U. S. 84, 91, between the decisions of the United States Circuit Court of Appeals of the Second Circuit, on the one hand, as laid down by that court in its decision in *Ruby Pickard v. United Aircraft Corp.*, 128 F. (2d), 632, in which it interpreted and applied the rule requiring a "flash of genius" to constitute invention; and the decisions and interpretation placed upon the decision of this Court in the *Cuno* case, by the United States Circuit Court of Appeals of the Seventh Circuit, as fully set forth by that court in the case of *Chicago Foundry Co. v. Burnside Foundry Co.*, 56 U. S. P. Q. 283, and the United States Circuit Court of Appeals of the Sixth Circuit in the case of *United States Gypsum Co. v. Consolidated Expanded Metal Co.*, 130 F. (2d) 888, 892. (Petition, p. 17.)

The United States Circuit Court of Appeals of the Second Circuit in the case at bar by questions and remarks by the Judges sitting at the oral argument, made it perfectly clear that they were following the rule laid down by that Court in the *Picard* case. Unfortunately, the questions asked and remarks made during an oral argument do not appear in the record. But, the opinion itself shows that the court relied solely upon the "flash of genius" *Cuno* decision of this Court, in reaching its decision in the case at bar.

We have also pointed out that in the present case the defendant expressly waived the issue of invention (Pet. pp. 2, 3, 4), and that the trial court overrode the defend-

ant's waiver of this issue and insisted upon holding that the patent was invalid (Pet. pp. 2, 3, 4).

The Second Circuit Court of Appeals also refused to recognize the waiver of the issue of invention and affirmed the District Court, and in this, we submit, the Circuit Court of Appeals also erred. This is in conflict with the decisions of this court.

Reasons for Urging a Rehearing.

We endeavored in our original Petition and Brief to make clear the great public importance of the clarification of the decision of this Court in the *Cuno* case, in definitely stating what this Court meant when it used the words "flash of genius"; in other words, we endeavored to make clear the need for this Court clarifying what is required to constitute invention.

So far as we have been able to ascertain, only three of the ten United States Circuit Courts of Appeals have announced their respective interpretations of what this Court meant by the "flash of genius" decision in the *Cuno* case; the United States Circuit Court of Appeals of the Second Circuit holding that there can be no invention in anything that is the mere product of "persistent and intelligent search for improvement." The Seventh and Sixth Circuits having expressed opposite opinions.

As we understand the decisions of the Second Circuit, the use of experimentation through trial and error of Armstrong and Marconi, that produced the radio, would not constitute invention. Other great inventions could be enumerated without number, that were produced by the same method, such as the incandescent light, sulfanilimide, insulin, etc.

If the United States Circuit Court of Appeals of the Second Circuit has correctly interpreted the "flash of genius" decision, it is of great public importance to the general public; to the owners of more than eight hundred thousand unexpired patents outstanding in the United States; to approximately ten thousand patent lawyers, that they may have a guide in advising their clients; to tens of thousands of general practicing lawyers; and to every manufacturer in the United States, whether manufacturing under presumed protection of patents, or not, and to the tens of thousands of prospective inventors and investors in patent rights, that this Court should state what it meant when it used the words "flash of genius."

We most respectfully submit, therefore, that this Court should definitely lay down a rule as a guide in determining what is required to produce a patentable invention under the "flash of genius" decision in the *Cuno* case.

On the other hand, if the United States Circuit Courts of Appeals of the Seventh and Sixth Circuits have correctly interpreted the decision of this Court in the commonly called "Flash of genius *Cuno* case," then, it is just as vital and of even greater public importance, to all of these classes enumerated above, as well as the general public, and the tens of thousands of prospective inventors and investors, that this Court should decide and clarify the question as a guide for their future conduct.

If the United States Circuit Court of Appeals of the Second Circuit has correctly interpreted the decision of this Court in the "flash of genius *Cuno* case," then, it is of great public importance that that fact be known, as it will mean that there will be very few, if any, inventors

who will even attempt to procure a patent, and very few, if any, who own patents who will attempt to litigate them when copied by competitors.

If the interpretation of the "flash of genius" *Cuno* decision of this Court as interpreted by the United States Circuit Courts of Appeals of the Seventh and Sixth Circuits is correct, then, it is of vital and imperative public importance, that this Court should decide that question at the earliest possible date, to prevent any further great and irreparable loss and damage resulting, and continuing to result from the misconstruction of the *Cuno* decision by the Circuit Court of Appeals of the Second Circuit.

It is of further great importance that this Court decide the conflict between the decisions of the United States Circuit Court of Appeals of the Second Circuit on the one hand; and the United States Circuit Courts of Appeals of the Seventh and Sixth Circuits, on the other hand, as a guide to all United States District Courts, to other United States Circuit Courts of Appeals, and to the United States Circuit Court of Appeals of the District of Columbia, to prevent further conflicting decisions.

Patent litigation is expensive, and many great inventions have been made by poor men, who are unable to bear the expense of litigation, and the conflict of decisions between the United States Circuit Courts of Appeals makes it impossible for them to obtain any assistance in carrying on their litigation, to protect their patents, no matter how valuable their patents may be, or how flagrant the infringement may be.

We most respectfully urge that this Court reconsider

our original Petition for Writ of Certiorari and Brief, and vacate the order denying a writ of certiorari to the United States Circuit Court of Appeals of the Second Circuit, and grant the Petition as prayed for, and also avail itself of the opportunity to make clear what it meant when it used the term "flash of genius" in the *Cuno* case.

Wherefore, petitioner prays that his Petition for Writ of Certiorari be reconsidered and granted.

Most respectfully submitted,

HARVEY S. COVER,

By JOSHUA R. H. POTTS,

EUGENE VINCENT CLARKE,

Attorneys for Petitioner.

May 28th, 1943.

We hereby certify that the foregoing Petition for Re-hearing is filed in good faith and not for the purpose of delay.

JOSHUA R. H. POTTS,

EUGENE VINCENT CLARKE.

